

REMARKS

Claims 2-3 remain for consideration, and new claims 4-16 are added to claim the invention in alternative language. All claims are thought to be allowable over the cited art.

Claim 1 is canceled without prejudice.

Claim 2 is amended to correct a typographical error.

Claim 3 is objected to as being dependent upon a rejected base claim and deemed allowable if rewritten. However, claim 3 remains dependent on claim 2 because claim 2 is thought to be allowable over cited art.

The Office Action does not establish that claim 1 is unpatentable 35 under USC §102(e) over US patent 6,654,889 to Trimberger ("Trimberger-1"). However, the rejection is now moot because claim 1 is canceled.

The Office Action does not establish that claim 2 is unpatentable 35 under USC §103(a) over Trimberger-1 in view of US patent 6,480,954 to Trimberger et al. ("Trimberger-2"). The rejection is respectfully traversed because Trimberger-1 is not thought to qualify as prior art. Furthermore, the Office Action fails to show that all the limitations are suggested by the references, fails to provide a proper motivation for modifying the teachings of Trimberger-1 with teachings of Trimberger-2, and fails to show that the combination could be made with a reasonable likelihood of success.

Common Ownership

Trimberger-1 is thought to not qualify as prior art under 35 USC §103(c). The present application was filed on 11/28/2000, and the present application and Trimberger-1 (US patent number 6,654,889 to Trimberger) were, at the time the invention of the present application was made, owned by Xilinx, Inc. Therefore, the rejection of claim 2 is moot and should be withdrawn.

Even if Trimberger-1 qualifies as prior art, the Office Action does not establish a *prima facie* case of obviousness.

Claim 2 includes limitations of disabling the PLD from being partially reconfigured, and the Office Action does not show that these limitations are taught by Trimberger-2's col. 40, ll. 15-30.

Trimberger-2 describes a method for time multiplexing a PLD between different configurations (Title, Abstract, col. 2, ll. 23-38). To achieve different configurations, additional configuration memory is implemented in the PLD, and the PLD switches between the different portions of configuration memory to achieve different configurations (col. 2, ll. 23-38). Thus, the cited section of Trimberger-2 that teaches disabling access to the configuration memory relates to disabling the configuration memory for the configuration that is inactive, not disabling partial reconfiguration. Thus, Trimberger-2 does not teach the limitations of claim 2.

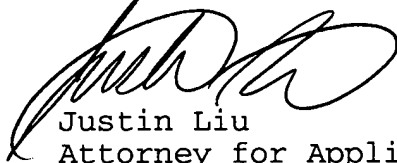
The alleged motivation for modifying Trimberger-1 with Trimberger-2 is conclusory, based on hindsight, and therefore, improper. The alleged motivation states that the combination would have been obvious "so as to protect proprietary configuration data for PLDs." It is respectfully submitted that the Office Action does not include any evidence from the prior art to support the alleged motivation. Furthermore, the alleged reason simply uses the present invention as the reason to support the combination. Therefore, the alleged motivation is improper.

The rejection of claim 2 over the Trimberger-1-Trimberger-2 combination should be withdrawn because the Office Action fails to show all the limitations are suggested by the combination, fails to provide a proper motivation for combining the references, and fails to show that the combination could be made with a reasonable likelihood of success. Therefore, the Office Action fails to establish a *prima facie* case of obviousness.

CONCLUSION

Reconsideration and a notice of allowance are respectfully requested in view of the Remarks presented above. If the Examiner has any questions or concerns, a telephone call to the undersigned is invited.

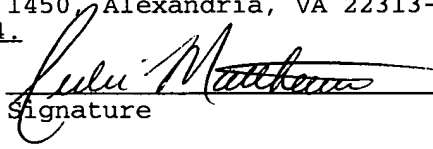
Respectfully submitted,



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I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Commissioner for Patents, P.O. BOX 1450, Alexandria, VA 22313-1450, on September 17, 2004.

Julie Matthews
Name


Signature